



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/289,000	02/25/97	BLATT	G 16683-1-2

QM12/1229  
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EXAMINER

PREBILIC, P

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

12/29/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/289,000

Applicant(s)

Blatt

Examiner

Paul Prebilic

Group Art Unit

3738



☒ Responsive to communication(s) filed on Feb 25, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-6, 8-10, and 24-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-6, 8-10, and 24-26 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The disclosure is objected to because of the following informalities:

On page 1, before the first line, the continuing data needs to be inserted therein with regard to parent application 08/452,227. Appropriate correction is required.

The amendment filed December 16, 1996 is objected to under 35 USC 132 because it introduces new matter into the disclosure. 35 USC 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

On page 10, line 21, "smooth" was added and on page 10, line 28, "non-porous" was added.

Applicant is required to cancel the new matter in response to this Office action.

Claims 1-6, 24, and 26 are rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the addition of the terms "smooth" and "non-porous" to the claims constitutes new matter because this language is not originally disclosed and one cannot reasonably come to the conclusion that this language is inherent or implicit to the original specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 8-10, and 24-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cohen (US 5,207,712) wherein the resection of bone ends or the holes drilled into the bone ends expose the cancellous bone surface and the solid sphere and rods are non-porous since they are called solid; see the whole document, especially Col. 3, lines 18-20; Figures 1-3 and 8-11.

With regard to claims 8 and 9, Applicant is directed to Figure 1 and especially Figure 2 for claim 8.

With regard to claim 24 specifically, the Examiner posits that a period of 6 to 7 months would be sufficient to allow all the natural processes of the permitting step as claimed to take place; see Col. 2, lines 45-48.

With regard to claims 4, 10, and 25 specifically, the estimating step as claimed is inherently or implicitly present in Cohen who makes his device for a particular joint type so that as much regrowth between the joints can take place.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. § 103 as being unpatentable over Cohen (US 5,207,712) in view of Delcommune et al (US 5,007,939). Cohen meets the claim language except for the use of lactic acid polymer or copolymer as claimed. Delcommune et al, however, teaches

that it has been known to use lactic acid polymer or copolymer for resorbable bone repair devices. Hence, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art to use lactic acid polymer or copolymer in place of in addition to the polymer of Cohen for the same reasons that Delcommune et al uses the same and in order to further reduce the cost of making the device.

#### Response to Arguments

In response to the arguments pertaining to the 35 USC 112, first paragraph rejection that one can determine this by viewing the drawings or by what is inherently present with pure polylactic acid, the Examiner posits that one cannot reasonably determine whether the surface of the device is smooth (or to what extent) or if the surface is porous merely by inspection of the drawings. In addition, there is no evidence in the specification and file that pure polylactic acid is smooth and non-porous. It is noted that only some of the claims are directed to polylactic acid and none to "pure polylactic acid". If it is inherent to pure polylactic acid that it is smooth and non-porous, Applicant needs to both provide evidence of this and put this limitation "pure polylactic acid" in all the claims so as to provide support and not expand the original meaning of the specification.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilio whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for this Group is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.



Paul Prebilic

Primary Examiner

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